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Attorney Docket No. LCB363

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

#12
9/28/03
Jm.

Applicant:	Lennart Axelsson)	
)	
Serial No.:	09/872,319)	Examiner: LEON, Edwin A.
)	
Filing Date:	June 1, 2001)	Group Art Unit: 2833
)	
For:	Improved Terminal Carrier)	
	Cut-Off Design)	

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Submitted herein in triplicate is Applicant's Appeal Brief as required by 37 CFR §1.192 and an authorization to pay the fee for filing a brief in support of an appeal under 37 CFR §1.17(c) and a request for an extension of time and payment of fee under 37 CFR §1.136(a).

I. Real Party in Interest

Per an assignment recorded in the above-captioned matter on June 1, 2001, Panduit Corp. is the real party in interest.

II. Related Appeals and Interferences

No other appeals or interferences are known to the Appellants, Appellants' legal representative, or the Assignee and Real Party in Interest which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending Appeal.

III. Status of Claims

All of the claims in the instant matter, claims 1-6, stand rejected and all of said claims are subject to the instant Appeal.

IV. Status of Amendments

No amendments have been filed in the above-captioned matter subsequent to the final non-advisory Office Action mailed April 23, 2003. A Reply including Remarks but no claim amendments was submitted June 23, 2003, but an Advisory Action mailed June 30, 2003 indicated that the June 23, 2003 submission failed to place the application in condition for allowance and further indicated that for purposes of Appeal, the proposed amendment(s) would not be entered.

V. Summary of the Invention

To address the problems caused by a high frequency of incomplete detachment, a new terminal is disclosed. The terminal is disposed on a carrier strip, and the terminal includes a contact portion and a generally round barrel portion attached to the carrier strip. The barrel portion has a generally squared shoulder where the barrel portion meets the carrier strip. The squared shoulder facilitates cutting the terminal completely from the carrier strip.

Also disclosed is a carrier strip integrally connecting and including a plurality of terminals. Each of the plurality of terminals includes a contact portion and a generally round barrel portion attached to said carrier strip. The barrel portion has a generally squared shoulder where the barrel portion meets the carrier strip. The squared shoulder facilitates the complete removal of the terminals from the carrier strip.

Also disclosed is a method for terminating an insulated wire having an insulated portion and exposed end with a terminal from a carrier strip. The terminal includes a contact portion, a generally round barrel portion attached to the carrier strip, the barrel portion including a generally squared shoulder where the barrel portion meets the carrier strip, and an intermediate portion disposed between the contact portion and the barrel portion. The method includes the steps of inserting the insulated wire having an exposed end into the terminal such that the exposed end is inserted substantially into the intermediate portion of the terminal and in electrical contact with the contact portion of the terminal and the insulated portion is inserted substantially into the barrel portion of

the terminal; crimping the intermediate portion of the terminal over the exposed end portion of the wire such that the contact between the contact portion of the terminal and the exposed wire portion is maintained; and cutting the terminal from the carrier strip by shearing the barrel portion of the terminal at the generally squared shoulder.

VI. Issues

Issue 1 -- Whether claims 1-6 are patentable under 35 USC §103(a) over Sonoda (U.S. Pat. No. 4,466,692) in view of Thillays (U.S. Pat. No. 4,292,735).

VII. Grouping of Claims

For each ground of rejection which Appellant contests herein, and which applies to more than one claim, such claims to which the ground of rejection applies, to the extent they are separately identified and argued below, do not stand or fall together.

VIII. Argument

Issue 1 -- Whether claims 1-6 are patentable under 35 USC §103(a) over Sonoda in view of Thillays.

The Examiner has taken the position that claims 1-6 are rendered obvious by the combination of Sonoda and Thillays. Not only does the Examiner fail to provide motivation for combining these references, however, but the proposed combination fails to teach, disclose, or otherwise suggest the claimed invention.

Independent claims 1 and 4 each recite a terminal having a cylindrical dielectric barrel portion having a generally squared shoulder disposed around a portion of the cylindrical barrel portion; the squared shoulder facilitating cutting or removing the terminal from a carrier strip. In the Office Action of April 23, 2002, the Examiner conceded that Sonoda, the primary reference, does not show a generally squared shoulder disposed around a portion of a cylindrical barrel portion. He then stated, however, that "Thillays discloses *the concept of having a generally squared shoulder (6)*, the squared shoulder (6) facilitating cutting the photoconductors (1) completely from the carrier strip (Fig. 3), and the squared shoulder (6) located at distinct points." (emphasis added). From this assertion alone, the Examiner stated that it therefore would have been obvious to one of ordinary skill in the art that at the time the invention was made to modify the terminal of Sonoda by including a generally squared shoulder as taught in Thillays "in order to ensure the shape accuracy of the terminal."

Even had the proposed Sonoda/Thillays combination been properly motivated by the prior art, which it is not, this combination does not yield the claimed invention. The alleged squared shoulder (6) of Thillays is not a shoulder at all and has no function similar to that of the squared shoulder of the claimed invention, i.e., facilitating cutting or otherwise removing a terminal completely from a carrier strip. Reference numeral (6) of Thillays actually refers to separation spaces interconnecting adjacent photoconductors (5) on an assembly of solidified resin (4) overlaid by an aluminum sheet (2). Grooves (9) are then provided in the sheet (2) in the central part of the separation spaces, giving the

bifurcated halves a shoulder-like appearance (col. 2, lines 56-64). They are not shoulders, however, in the context of the claimed invention. First, they are not disposed around a portion of a cylindrical barrel portion, and, second, they do not facilitate any sort of cutting or removal, much less with respect to a terminal and carrier strip.

While the Examiner claimed that the squared shoulder (6) facilitates the cutting of the photoconductors (1) completely from the carrier strip, Figure 4 of the reference and the textual description thereof do not support this claim. As indicated in col. 3, lines 6-10 of the Thillays reference, the Thillays method involves a fine tip (10) provided on the rear face of a flexible disc (7) so as to lift an element (5) which then detaches from the disc (7). Simultaneously, the element (5) is attracted by a vacuum pick-up (11). Thus, there is nothing in Thillays to suggest that the alleged squared shoulder (6), as the Examiner identified it, facilitates cutting photoconductors from any carrier strip. Assuming that the Examiner is analogizing a carrier strip to the disc (7), from which the photoconductor element (5) is removed, there is no cutting at all, much less any cutting device directed at the squared shoulder to facilitate severance. Thus, even if the prior art somehow suggested the propriety of combining the Thillays reference with the Sonoda reference, it would not teach modification of the Sonoda reference in the manner that the Examiner has suggested to achieve the claimed invention.

Additionally, the Examiner has failed to indicate any suggestion in the art to combine these two references. For a claim to be invalid for obviousness over a combination of references, there must have been a motivation to combine the prior art

references to produce the claimed invention. *Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc.*, 145 F.3d 1303, 46 USPQ.2d 1752 (Fed. Cir. 1998). Especially given how far afield the subject matter of the Thillays reference is from the technology of cutting terminals from a carrier strip, the Examiner has failed to identify any motivation in the art to combine these references. When relying on numerous references or a modification of prior art, it is incumbent upon the Examiner to identify some suggestion to combine references or make modification. *In re Mayne*, 104 F.3d 1339, 41 USPQ.2d, 1451 (Fed. Cir. 1997). The Examiner has not identified that suggestion within the references or the art generally, and it is therefore inappropriate to combine these references.

Thus, the combination of references proposed by the Examiner is not suggested by the prior art and, regardless, fails to teach the claimed invention. Applicant respectfully submits that pending claims 1-6 are patentable under §103(a), and are allowable generally.

Respectfully submitted,

Date: September 23, 2003


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APPENDIX A

1. A terminal disposed on a carrier strip, said terminal comprising:
an electrically conductive contact portion; and
a generally cylindrical dielectric barrel portion having a generally squared shoulder disposed around a portion of said cylindrical barrel portion such that a cross section of said barrel portion taken at said carrier strip includes a generally round portion not adjacent said carrier strip and a generally squared portion adjacent said carrier strip, said squared shoulder facilitating cutting said terminal completely from said carrier strip.
2. A terminal in accordance with claim 1 wherein said round barrel portion of said terminal is attached to said carrier strip at two distinct points and said generally round barrel portion has a generally squared shoulder at each of said distinct points.
3. A terminal in accordance with claim 1 wherein said terminal further comprises a dielectric intermediate portion disposed between said contact portion and said barrel portion.
4. A carrier strip integrally connecting and including a plurality of terminals, each of said plurality of terminals comprising a contact portion and a generally cylindrical dielectric barrel portion attached to said carrier strip, said barrel portion having a generally squared shoulder disposed around a portion of said cylindrical barrel portion,

said squared shoulder facilitating the complete removal of said terminals from said carrier strip.

5. A carrier strip in accordance with claim 4 wherein each of said plurality of terminals further comprises a dielectric intermediate portion disposed between said contact portion and said barrel portion.

6. A carrier strip in accordance with claim 4 wherein said plurality of terminals are integrally connected with links of said carrier strip and said terminals are arranged on said carrier strip such that there are first and last end terminals with a plurality of intermediate terminals disposed between said end terminals on said carrier strip, wherein each of said end terminals includes a barrel portion having only a single generally squared shoulder where said barrel portion meets one of said links of said carrier strip and each of said intermediate terminals includes a barrel portion having a pair of generally squared shoulders generally diametrically opposed on said barrel portion such that each shoulder meets one of said links of said carrier strip.